SUBJECT INDEX

	Page
Jurisdiction	1
No Justiciable Question Presented	2
Factual Statement of the Case	4
No Valid "Reasons" in Support of the Petition Are Advanced by Petitioner	8
Petitioner Fabricates Non-Existing Problems	12
Petitioner's Third Question Is Sham	14
Conclusion	16

TABLE OF AUTHORITIES CITED

Cases	Page
A. J. Deer Co. v. U.S. Slicing Machine Co., 21 F. 2d 812	9
Allied Wheel Products v. Rude, 206 F. 2d 752	12
B & M Corp. v. Koolvent Aluminum Awning, 257 F. 2d 264	12
Blake v. Bassick Co., 262 F. Supp. 910	11
Blake v. San Francisco, 113 U.S. 679	9
Brown v. Piper, 91 U.S. 37	9
Calmar Inc. v. Cook Chemical Co., 383 U.S. 26	5, 10, 13
Copeman Laboratories v. General Plastics Corp., 149 F. 2d 962	12
Cuno Corp. v. Automatic Devices Corp., 314 U.S. 84	10
General Metals Powder Co. v. S. K. Wellman, Co., 157 F. 2d 505	12
Graham v. Deere, 383 U.S. 1	2, 8, 10, 12
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147	8, 15
Hotchkiss v. Greenwood, 11 How. 248	8, 10
Howe Machine Co. v. National Needle Co., 134 U.S. 388	10
Kylstra, In re, 87 F. 2d 487	11
Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 845	8
Printing Plate Supply Co. v. Crescent Engraving, 246 F. Supp. 654	12

Page

Stearns v. Tinker and Rasor, 220 F. 2d 49 8

Stephanson v. Brooklyn RR Co., 114 U.S. 149 9

Van Wanderham, In re, 378 F. 2d 981 11

Miscellaneous

Supreme Court Review (1966), p. 400 3

Rules

Rules of the Supreme Court, Rule 19 3

Statute

United States Code, Title 35, Sec. 103 2

IN THE

Supreme Court of the United States

October Term, 1967
No. 851

PACIFIC SCIENTIFIC COMPANY,

Petitioner,

vs.

AEROTEC INDUSTRIES OF CALIFORNIA, AEROTEC INDUSTRIES, INC., and UNIVERSAL OIL PRODUCTS COMPANY,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITIONER'S PETITION FOR WRIT OF CERTIORARI.

Respondents hereby oppose the Petition for Writ of Certiorari filed herein by Petitioner on the primary ground that no special or important reasons exist for review by this Court.

JURISDICTION.

The grounds for jurisdiction, the constitutional provisions involved and the references to the Opinions and Findings of Fact below are adequately set forth in the Petition and Appendix thereto and will be referred to herein.[1]

[1] "Pet. (page number)" shall refer to page of Petition herein. "A. (page number)" shall refer to page of Appendix to Petition.

NO JUSTICIABLE QUESTION PRESENTED.

The alleged questions presented on pages 2 to 4 of the Petition are hypothetical, without substance and misleading. When the first two questions fabricated by Petitioner are stripped of their sophistry, it becomes evident that the actual underlying question has previously been answered by this Court. Petitioner is asking this Court to lower the standard of patentability and the first two purported questions posed by Petitioner can be concisely stated:

1. Did Congress by enacting 35 U.S.C. §103, and the Supreme Court in deciding *Graham v. Deere,* 383 U.S. 1 (1966)

(a) intend to lower the standard of patentability applied by the Supreme Court in its prior decisions?

(b) intend to restrict the applicability of pertinent prior art in determining patentability, and thereby depart from the criteria established by prior decisions of this Court?

This Court has disposed of the above questions—

"We have been urged to find in §103 a relaxed standard, supposedly a congressional reaction to the 'increased standard' applied by this Court in its decisions over the last twenty or thirty years. The standard has remained invariable in this Court."

383 U.S. at 19.

"We believe that this legislative history as well as other sources, show that the revision was not intended to change the general level of patentable invention."

383 U.S. at 17.

> "* * *, it bears repeating that we find no change in the general strictness with which the overall test is to be applied."
>
> 383 U.S. at 19.

Petitioner's third question is totally hypothetical and baseless and does not present a justiciable question but simply argues with the facts. A glance at the Judgment of the Court of Appeals in this case, particularly page 36 and pages 44 and 45 (as reproduced in the Appendix to the Petition) shows that the Court of Appeals was compelled to hold the patent invalid on pertinent art not cited by the Patent Office.

No valid reasons exist in support of the Petition. Pertinent prior art varies with the subject matter of each case. This Court has repeatedly given examples and rules applicable to pertinent prior art (see pages 8-11 of this Brief). Even Professor Kitch (relied upon and partially cited by Petitioner, Pet. 26), admits that this Court defined pertinent art in the *Cook* cases, stating—

> "* * * it is the art to which one can reasonably be expected to look for a solution to the problem which the patented device attempts to solve. This is the definition of the pertinent art that the Supreme Court adopted in Cook." (Supreme Court Review 1966, p. 400).

It is submitted that the Petition for Writ of Certiorari should be denied since it does not present questions within the purview of Rule 19 of this Court. This Court should not waste its time on moot questions. The Judgment of the Court of Appeals was in conformity with the standards established by this Court in many prior decisions.

FACTUAL STATEMENT OF THE CASE.

Petitioner's patents resulted from applications filed in 1953 and issued as patents 2,845,233 and 2,845,234 on July 29, 1958. The patents relate to "safety apparatus" which permit a person or object, such as a package of freight (specifically mentioned in patent '233, Col. 7, lines 121-125), to move freely with respect to a vehicle, such as an airplane, but to become locked in position by forces generated by abnormal or violent motion of the vehicle.

The patents in suit must be viewed in the light of all art prior to 1953. With reference to prior art, the patentees admitted:

> "Safety apparatus of this type have been developed over the years and comprise devices for use in conjunction with a shoulder harness which permit movement of the shoulder harness and consequent movement of the upper portion of the pilot's body during normal motion of his craft but which automatically operate to restrict movement of the shoulder harness and pilot during abnormal or violent motions of the craft." [Patent 2,845,233, Col. 1, lines 23-30, Ex. 1].

The Patent Office cited a number of such cable-locking devices, including Sharpe 2,370,921 (1945), Geohegan 2,403,653 (1946), Nordmark 2,434,119 (1948) and Nordmark 2,701,693 (1951). The last three cited patents clearly showed cable-locking devices specifically adapted for use by aircraft occupants and

> "* * * by means of which an occupant of an airplane or other vehicle is secured in his chair." [Patent 2,434,119, Col. 1, lines 4-6, Ex. D].

The above patent also states that its object was:

> "* * * to provide a reel for reeling in and paying out the cable of a shoulder harness to permit freedom of movement to the wearer of the harness, which reel has inertia-actuated parts for preventing paying out of the cable during a collision or crash landing and which has means for positively locking the reel during such emergency and maintaining the same in locked condition until such emergency has passed and the reel is manually unlocked." [Col. 1, lines 10-19].

The Patent Office rejected all claims and, upon appeal to the Patent Office Board of Appeals, the patentees did not argue that they had a new combination; they argued that devices of the prior art patents were not responsive to acceleration and did not have an inertia element. The Board allowed the claims.

But neither the Patent Examiner nor the Board of Appeals had before it the prior art patents which showed inertia elements responsive to acceleration of the connecting cable. Apparently neither the Patent Office Examiner nor Petitioner had conducted a patent search, —"* * * a prudent and nowadays common preliminary to well organized research" advocated by this Court in *Calmar Inc. v. Cook Chemical Co.*, 383 U.S. 26 at 36.

This uncited prior art was considered by the Court of Appeals in the instant litigation and is exemplified by the so-called trolley catcher patents: Ham 700,763 (1902); Burdon 888,418 (1908) and Ricketts 1,383,570 (1921). All of these patents show acceleration responsive devices. Each of the devices is attached to a vehicle (trolley car), includes a reel and a cable running

to a pole. The trolley pole maintains contact with an overhead wire and may move up and down and sideways (around corners) when the motions are relatively slow, but if the trolley leaves the trolley wire, it is restrained from rising to a dangerous height. Certainly these devices are safety devices. It is to be noted that the device permits normal easy movement of the object to which the cable is attached (the trolley pole);—

> "When, however, a sudden jerk of the trolley calls for the instant action of the trolley-catcher, the intertia-controlled clutch mechanism acts at once." (Ham, 700,763, p. 2, lines 114-117).

Rickets 1,393,570 employs more polished language and states that his device

> "* * * operates in response to sudden variation in acceleration of rotative movement of the winding drum." (p. 3, lines 65-67).

Clearly, therefore, the argument advanced by Petitioner before the Patent Office Board of Appeals, who did not have this uncited prior art, fails completely in the light of this uncited art.

During trial, Petitioner was forced to concoct a totally meaningless phrase and attempted to predicate patentability upon semantics. They now state that their device is "Man sensitive". A machine does not discriminate as to who or what applies the effective force. The patentees themselves state that their cable or strap can be attached to a harness or a man or to a box of freight. It does not make a bit of difference to the device. A weighing scale will weigh a man, a woman or a box of freight. Is it invention to call the scale "man sensitive" when a man actuates it?

The Court of Appeals for the Ninth Circuit held the patents invalid in a well considered opinion in which they followed their usual practice and the admonition of this Court by considering the scope and content of the prior art, the differences between the prior art and the subject matter of the claims in issue, the level of skill in the art and, against this background, the obviousness of the subject matter.

The Court of Appeals disposed of the meaningless phrase "man sensitive" and felt that it had helped to lead the Trial Court astray (A. 39). The Court studied the prior art patents and their modes of operation and purposes attained. They pointed out that the elements of the device of the prior patents are "strikingly similar and so are their purposes" (A. 47). In their opinion, they applied the Ham device to claim 1 of Petitioner's patent '233 (A. 44-45). They were unable to find any unexpected, unobvious or unusual result flowing from this old combination of old elements. Petitioner had simply made an obvious substitution of the old Ham device for the device shown in the expired Nordmark patent.

Petitioner's attack on the prior art upon the ground that it is not analogous is completely refuted by the testimony of Mr. Pfankuch, patentee of Petitioner's patent 2,845,233. Mr. Pfankuch testified that the patented device attains the same purpose and result as the trolley catchers, since it would lock up and restrain a trolley pole if Petitioner's device was on a trolley car and its cable was attached to a trolley pole [R. T. 298-299].

The Court of Appeals was compelled to hold the patents invalid for failure to comply with the require-

ments of patentability repeatedly enunciated by this Court, from the days of *Hotchkiss v. Greenwood,* 11 How. 248 (1950) and *Lincoln Engineering Co. v. Stewart-Warner Corp.,* 303 U.S. 845 (1938) to *Great A & P Tea Co. v. Supermarket Equipment Corp.,* 340 U.S. 147 (1950) and *Graham v. Deere, supra.*

NO VALID "REASONS" IN SUPPORT OF THE PETITION ARE ADVANCED BY PETITIONER.

Petitioner primarily asserts, as "reasons for granting the writ", that the Court of Appeals erred in applying the rule with respect to analogous art, quoted in the Court's Opinion (A. 46) as follows:

> "'The rule laid down by many of the authorities is that whether arts or uses are analogous depends upon the similarity of their elements and purposes. It is said that if the elements and purposes in one art are related and similar to those in another art, and because and by reason of that relation and similarity make an apeal to the mind of a person having mechanical skill and knowledge of the purposes of the art, then such arts must be said to be analogous; and, if the converse is true, they are non-analogous arts.'"
>
> *Stearns v. Tinker and Rasor,* 220 F. 2d 49 at 56-7 (C.A. 9, 1955).

Petitioner's reason is baseless and false. In the first place, Petitioner had relied upon the *Stearns* case and it is to be noted that the Circuit Court stated (A. 46):

> "Appellee [Petitioner here] cites and relies upon our decision in *Stearns v. Tinker and Rasor,* Ninth Circuit 1955, 220 F.2d 49 at 56-7. But we think

> that the test there laid down, when applied here, supports the Appellant's position rather than that of Appellee."

The rule as stated by the Ninth Circuit is a paraphrase of the rule stated by the Seventh Circuit in *A. J. Deer Co. v. U.S. Slicing Machine Co.*, 21 F. 2d 812 at 813 in 1927. It is followed by the Sixth, Seventh, Ninth and other Circuits.

The rule is in accord with a long line of Supreme Court cases, including the following:

Brown v. Piper, 91 U.S. 37 (1875) wherein the use of ice and a container in the preservation of a corpse was analogous to the use of ice and a container in the freezing of ice cream or fish.

In *Blake v. San Francisco*, 113 U.S. 679 (1885), the use of a valve on steamships with steam was analogous to the use of the valve on land with water, the Court stating:

> "It follows from this principle that, where the public has acquired in any way the right to use a machine or device for a particular purpose, it has the right to use it for all the like purposes to which it can be applied, and no one can take out a patent to cover the application of the device to a similar purpose." (at 682).

In *Stephanson v. Brooklyn RR Co.*, 114 U.S. 149 (1885), prior art relating to the opening and closing of furnace doors, sliding window blinds and shutters was considered analogous to a device for opening and closing the rear door of a street car from the front thereof.

In *Howe Machine Co. v. National Needle Co.,* 134 U.S. 388 (1889), the patent related to a machine for turning sewing machine needles and was held invalid on prior art relating to turning of wooden skewers, the Court stating that it was "* * * for an analogous or double use, and not patentable."

In *Cuno Corp. v. Automatic Devices Corp.,* 314 U.S. 84 (1941), prior art including electric heaters used in vulanizing rubber, a coffee cooker in which a thermostat operated to open and close a circuit intermittently, an electric bread toaster, an electric flatiron, etc. were deemed analogous prior art in holding invalid a patent relating to a "wireless" cigarette lighter, this Court stating:

> "Certainly the use of a thermostat to break a circuit in a 'wireless' cigar lighter is analogous to, or the same in character as, the use of such a device in electric heaters, toasters, or irons, whatever may be the difference in detail of design. Ingenuity was required to effect the adaptation, but no more than that to be expected of a mechanic skilled in the art." (at 91, 92).

In the *Cuno* case, as in *Graham v. John Deere Co.* and *Calmar v. Cook* (companion case, 383 U.S. 26), this Court reiterated the principles enunciated by *Hotchkiss v. Greenwood,* 11 How. 248 (1850). In the *Calmar v. Cook* case, this Court also confirmed the applicability of analogous art (which Petitioner now wants to restrict) as indicated by the following quotation:

> "Cook Chemical argues however, that Livingston is not the pertinent prior art because it refers to liquid containers having pouring spouts rather than

> pump sprayers * * * **so restricted a view of the applicable prior art is not justified.** The problems confronting Scoggin and the insecticide industry were not insecticide problems; they were mechanical closure problems. Closure devices in such a closely related art as pouring spouts for liquid containers are at the very least pertinent references." 383 U.S. at 35.

The above decisions of this Court confirm that you "* * * find no change in general strictness with which the test is to be applied" and that "the standard has remained invariable in this Court."

A full answer has been given by this Court heretofore to any question presented by the Petitioner. The Petition should be denied.

A discussion of the Court of Customs and Patent Appeals' cases cited by Petitioner (Pet. 13-23, 28, 31) is deemed unnecessary. These are not inter partes, contested cases in which uncited prior art was considered. The rule there stated in different words is fundamentally the same as that applied in the instant case, but the facts are different. Petitioner fails to mention that *In re Van Wanderham,* 378 F.2d 981 (CCPA 1967), the Court eferred to its decision *In re Kylstra,* 87 F. 2d 487 at 489 wherein, if the invention relates to the counting art, then a street car register is analogous to an ammunition counter. Here, Petitioner's patents relate to the art of restraining objects, and a device which exerts such restraint upon a cow or a trolley pole is analogous to one where the object is a box of freight or a man.

Petitioner refers to two maverick District Court cases (Pet. 20), namely, *Blake v. Bassick Co.,* 262 F.

Supp. 910 and *Printing Plate Supply Co. v. Crescent Engraving,* 246 F. Supp. 654. These are from District Courts in the Sixth and Seventh Circuits. The Courts of Appeal of these two circuits have consistently followed the rule stated in the *A. J. Deere* case *supra* as shown by *Copeman Laboratories v. General Plastics Corp.,* 149 F. 2d 962 (CA 7, 1945); *B & M Corp. v. Koolvent Aluminum Awning,* 257 F. 2d 264 (CA 7, 1958); *General Metals Powder Co. v. S. K. Wellman, Co.,* 157 F. 2d 505 (CA 6, 1946); and *Allied Wheel Products v. Rude,* 206 F. 2d 752 (CA 6, 1953).

Petitioner fails to show that the rule relating to the consideration of prior art by the Ninth Circuit differs from that advocated by this Court and followed in the Sixth, Seventh, or any other Circuit. No question of conflict with accepted Federal judicial procedure is presented, and the Petition for Writ of Ceriorari should be denied.

PETITIONER FABRICATES NON-EXISTING PROBLEMS.

Petitioner and his patentees did not invent commercial or military aircraft; they did not invent pilots; they did not invent harnesses, straps or cable-locking devices for pilots. The problem of permitting a pilot to move (in making flight adjustments) and locking him from being thrown in a crash or under abnormal motion of an airplane, was disclosed and solved in the Nordmark patent 2,434,119 which expired in 1965, and in the Geohegan patent.

Rapid growth of the aircraft industry opened the doors to the use of numbers of safety devices per plane. A skilled mechanic is asked to make a better device than

is shown in Nordmark. He does what this Court suggested in *Calmar v. Cook* and avails himself of the knowledge stored in the United States Patent Office. He finds the Ham, Burdon and Ricketts patents which are responsive to acceleration of the cable.

So he simply substitutes one cable-locking device (the Ham device which is in the public domain) for another cable-locking device (the Nordmark device) in the same old combination of vehicle, device with reel, cable, object (man, freight, or trolley pole) to attain the same purpose or result, *i.e.* to lock the cable and hold the object when the object imparts acceleration to the cable.

As in *Calmar v. Cook,* the skilled mechanic did not have to solve a problem involving patentability.

> "The substitution of a rib built into a collar likewise presents no patentable difference above the prior art. It was fully disclosed and dedicated to the public in the Livingstone patent. * * * The problems confronting Scoggin and the insecticide industry were not insecticide problems; they were mechanical closure problems. Closure devices in such a closely related art as pouring spouts for liquid containers are at the very least pertinent references."
>
> 383 U.S. at 35.

It is significant to note that Petitioner does not deny that the devices of Ham, Burdon and Ricketts read directly upon claims of the patents in suit. This is clearly shown by the colored Exhibits I and R reproduced in Appendix C, pages 1 and 2 of Appellants' (Respondents') Opening Brief before the Ninth Circuit. These Exhibits and testimony thereon were unrebutted and unrefuted.

PETITIONER'S THIRD QUESTION IS SHAM.

In a further attempt to fabricate an issue, Petitioner alleges that the Ninth Circuit Court erred in not according binding force to the Trial Court's findings, not clearly erroneous. But a careful reading of the decision of the Court of Appeals for the Ninth Circuit in this case clearly shows that the Court did consider the Findings and pointed out wherein the Findings were in error.

Findings 14, 16, 18, 19, 20, 21, 22, 36, 49, 52, 56, 59, 60 and 61 are based upon the so-called "man-sensitive" ability of the device. The Court of Appeals discusses that aspect and clearly states:

> "The Trial Court used the phrase 'man-sensitive' to describe these devices. This anthropomorphic phrase does not add to the clarity of thought. The reels do not 'sense' the movements of a man. They clearly respond to physical forces when the latter are applied to the cord or strap wound on them by whatever body, animate or inanimate, may be attached to it." (A. 39).

The Court of Appeals supports this with a quotation from Petitioner's patent which states that the device:

> "* * * may be used in connection with objects other than human beings, such as, for example, freight handling and the like."

The Court therefore recognized that Petitioner's false attribution of "sensing" helped to lead the Trial Court astray and that Findings based upon this erroneous and unjustified "man-sensitive" attribute were in grievous and reversible error.

Similarly, Findings 42, 53, 57 and 64 were in error since they referred to sensing the movement of a man with respect to a seat. It may be noted that one of the prior patents, No. 2,370,921 to Sharpe, disclosed an acceleration-responsive device for preventing cows from kicking when they are milked. Is not the kicking movement of a cow a movement with respect to her "seat"?

The Court of Appeals, in its decision, specifically referred to Findings (prepared by Petitioner) in which the Trial Judge attempted to distinguish the trolley catcher patents on several grounds, and concluded "None, we think, has merit." (A. 45). The reasons for such conclusion are discussed by the Court of Appeals (A. 45, 46, 47, 48) and such reasons are based on standards of patentability enunciated by this Court.

The claims of the patents in suit were for combinations of old elements, for an old purpose—to lock a cable under acceleration. The Court of Appeals followed the admonition of this Court—

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."
>
> *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 at 152.

The Judgment of the Court of Appeals in this case shows that the art, both cited and uncited, was carefully considered, and lack of patentability was established by the application of statutory standards and rules established by the Supreme Court of the United States.

CONCLUSION.

General Rules laid down by this Court and stated in the Patent Act have been applied by the Court of Appeals for the Ninth Circuit to uncontroverted facts. The Judgment which this Court is asked to review is not in conflict with the decisions of this Court or any other Court of Appeals. No new question has been decided by the Ninth Circuit.

The Petition does not point to a single error of fact or law. The Ninth Circuit recognized its duty to relieve the public from an asserted monopoly where the constitutional standards of patentability to not exist.

It is submitted that the Petition for Writ of Certiorari should be denied since

(a) the hypothetical and strained questions presented are simply an attempt to restate questions previously settled by this Court, and

(b) it does not present questions requiring judicial review or coming within the purview of Rule 19 of this Court.

Respectfully submitted,

CASIMIR A. MIKETTA,
Attorney for Respondents.

Of Counsel:

E. SEWARD STEVENS of
GUION & STEVENS,
P.O. Box 338,
Litchfield, Conn. 06759,

MIKETTA, GLENNY, POMS & SMITH,
210 West Seventh Street,
Los Angeles, Calif. 90014.